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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/829,708	04/10/2001	R. Dennis Nesbitt	P-5686-C1	2621

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EXAMINER

HUNTER, ALVIN A

ART UNIT

PAPER NUMBER

3711

DATE MAILED: 03/05/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/829,708

Applicant(s)

NESBITT ET AL.

Examiner

Alvin A. Hunter

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 April 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

1. Claims 1-14, 31, and 35-37 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-9 of U.S.

Patent No. 6,213,895 in view of OFFICIAL NOTICE. Although the conflicting claims are not identical, they are not patentably distinct from each other because the same subject matter is claimed except having one of the inner and outer cover layers and the single cover comprising polyurethane. OFFICIAL NOTICE is taken that covers are conventionally made of ionomer resins due to their durability, abrasion resistance, and toughness. Polyurethanes also have abrasion resistance, toughness, and durability properties also; therefore, it would have been obvious, in view of the OFFICIAL NOTICE, to have a polyurethane cover in order to give the golf ball similar properties that would have been imparted to it by a cover made of an ionomer resin.

2. Claims 15-17, 19, and 35 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-17 of U.S. Patent No. 6,245,859. Although the conflicting claims are not identical, they are not patentably distinct from each other because the same subject matter is claimed except claiming the inner cover layer being softer than the outer cover layer. One having ordinary skill in the art would recognize the having the inner cover layer softer than the outer cover layer would not affect the performance of the ball. U.S. Patent No. 6,245,859 claims the covers being at least 65 Shore D and the present application claims an option of having an inner cover with a Shore D hardness of 65 or less and the outer layer having a Shore D hardness of 65 or greater. Both cover layers in the present application are capable of having a hardness of 65; furthermore, U.S. Patent No. 6,245,859 claims the cover having a Shore D hardness of at least 65, wherein the cover comprises an inner and outer cover layer. The cover of U.S. Patent No. 6,245,869 appears to be an average of both layers and inherently clarifies that either the inner cover layer and outer cover layer must be the same, the inner cover layer must be higher, or the inner cover layer must be lower than the hardness of the outer cover layer; therefore, it would have been obvious to one having ordinary skill in the art to having a inner cover layer softer than the outer cover layer in order to provide the desired toughness and overall hardness to the cover as a matter of routine optimization.

3. Claims 18, 20, 21, and 22 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-17 of U.S. Patent No. 6,245,859 in view of Sullivan et al. (USPN 6213895). Although the

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conflicting claims are not identical, they are not patentably distinct from each other because the same subject matter is claimed except having more than one core layer, the center component of the core being 0.500 to 1.250, the dual core having a diameter of 1.25 to 1.600, the core layer having a density increasing agent which is foamed or reduced in density. Sullivan et al. discloses a golf ball having a dual core configuration in which an optional core layer may be added. In Column 4, lines 1 through 29 use the core to impart resilience and restitution to the golf ball. Sullivan et al. does not disclose any advantages to the addition of the optional core layer; therefore, one having ordinary skill in the art would assume that it do not change the performance of the golf ball. Furthermore, if the center component of the core can be up to 1.25 inches and the dual core can have a minimum of 1.25 inches, one would assume the invention would work with just the center component. It would have been obvious to one having ordinary skill in the art, in view of Sullivan et al., to provide the golf ball with any number of optional core layers at any size in order impart the desired resilience and restitution to the golf ball. Sullivan et al. also discloses that fillers may be added to the cores to increase or decrease the density, in which Sullivan et al. solicits that the filler may be foamed (See Column 22, lines 57 through 67; and Column 23, lines 1 and 2). Therefore, it would have been obvious to one having ordinary skill in the art, in view of Sullivan et al., to add any type of filler to the cores of U.S. Patent No. 6245859 in order to increase or decrease the density of the cores which increases or decrease the mass or weight of the core and golf ball.

4. Claims 23 and 24 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-17 of U.S. Patent No. 6245859 in view of Sullivan (USPN 6224498). Although the conflicting claims are not identical, they are not patentably distinct from each other because the same subject matter is claimed except having an inner or outer cover layer having an ionomer resin greater than 16% weight. Sullivan disclose a golf ball having a golf ball with an inner cover layer having an ionomer of 16% or less weight and an outer cover having a high modulus ionomer resin (16% or less weight) (See Summary of the Invention). The inner cover layer's composition imparts improve spin, feel, and softer compression to the golf ball than that of a inner cover layer made from a high acid ionomer (See Summary of the Invention). One having ordinary skill in the art can conclude that low acid and high acid ionomers both improve spin, feel, and compression merely because of Sullivan not disclosing any undesired effects; therefore, it would have been obvious in view of Sullivan to construct a golf ball having inner and outer cover layers with either high or low acid ionomers in order to obtain the desired spin, feel, and compression of the golf ball through the process of routine optimization. Sullivan also discloses that blending an low and high acid ionomer results in increased travel distance and spin; therefore it would have been obvious to have an inner cover layer with a second ionomer resin having 16% or more weight percent acid, as taught by Sullivan, to obtain the desired travel distance and spin of the golf ball.

5. Claims 24-30 and 34 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 11 of U.S.

Patent No. 6057403. Although the conflicting claims are not identical, they are not patentably distinct from each other because the same subject matter is being claimed except U.S. Patent No. 6057403 claims an inner and outer cover. The outer cover comprises a non-ionomeric thermoplastic elastomer in which polyester polyurethane is claimed (See Claim 1 and 11). Golf ball covers are majority made of ionomer resins because of their durability, abrasion resistance, and toughness. Polyurethane is also known for its abrasion resistance, durability, and toughness properties and would have performed the same regardless of how many cover layers the golf ball has; therefore, it would have been obvious to one having ordinary skill in the art to have a cover made of polyurethane in order to impart the abrasion resistance, durability, and toughness properties that would typically be impart to the golf ball by an ionomer resin cover. Furthermore, cast, thermoset, and thermoplastic polyurethane have similar properties and would have been obvious to use any type of polyurethane to impart the properties above that the ionomer resin would have imparted to it.

6. Claim 32 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 15 and 16 of U.S. Patent No. 6245859 in view of Sullivan (USPN 6267693). Although the conflicting claims are not identical, they are not patentably distinct from each other because the same subject matter is claimed except having an acrylic acid based ionomer resin. Sullivan discloses a golf ball having an ionomer resin cover in which contains acrylic acid neutralized by metal ions such as zinc, sodium, and magnesium (See Entire Document). The playability and durability characteristics are improved due the resin containing acrylic

acid. It would have been obvious, in view of Sullivan, to one having ordinary skill in the art at the time the invention was made to have an acrylic acid based ionomer resin neutralized with a metal cation to improve the playability and durability of the golf ball.

7. Claim 33 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6213895.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the same subject matter is claimed except for the single cover hardness and having inner and outer cover layers. It would appear that in the present application that the hardness, which imparts toughness, of the components are not critical; therefore, it would have been obvious to construct a golf ball with components of any hardness in order to give the golf ball toughness.

8. Claim 33 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6245859.


Although the conflicting claims are not identical, they are not patentably distinct from each other because the same subject matter is being claimed except for the core having a Riehle compression of at least 75, a cover having a hardness of at least 65, and the core and center later being thermoplastic. The Riehle compression imparts restitution and resilience to the golf ball, the hardness imparts toughness to the golf ball, and the type of material is not critical as long as it assist in imparting resilience to the dual core. One would have been motivated to have a golf ball of any Riehle compression, hardness, or material in order to obtain the desired restitution, resilience, and toughness for a golf ball as a matter of routine optimization.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alvin A. Hunter whose telephone number is 703-306-5693. The examiner can normally be reached on Monday through Friday from 7:30AM to 4:00PM Eastern Time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul Sewell, can be reached on (703) 308-2126. The fax phone number for the organization where this application or proceeding is assigned is 703-308-7768.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.


Paul T. Sewell
Supervisory Patent Examiner
Group 3700